UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,929	12/30/2003	Jeron Wayne Coolman		7093

31688 7590 07/19/2007

TRAN & ASSOCIATES
6768 MEADOW VISTA CT.
SAN JOSE, CA 95135

EXAMINER	
MISIASZEK, MICHAEL	
ART UNIT	**PAPER NUMBER**
3625	

MAIL DATE	DELIVERY MODE
07/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/747,929
Filing Date: December 30, 2003
Appellant(s): COOLMAN ET AL.

Bao Tran
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/18/2007 appealing from the Office action mailed 5/26/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2005/0060235	Byrne	8/27/2003
6754672	McLauchlin	10/19/2000
5319642	King, Jr. et al.	9/27/1990
2004/0117263	Gieselmann et al.	4/1/2002
2003/0088475	Goodman et al.	10/12/2001
2003/0126036	Muscavage, III et al.	11/14/2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne (US 2005/0060235 A2) in view of McLauchlin (US 6754672 B1).

Claims 3-5 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin and further in view of King, Jr. et al. (US 5319542,).

Claims 6-8 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin and further in view of Gieselmann et al. (US 20040117263 A1).

Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin and Gieselmann and further in view of Goodman et al. (US 20030088475 A1).

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin and Gieselmann and further in view of King and Muscavage, III et al. (US 20030126036 A1).

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Claims 9 and 19 were previously rejected under 35 U.S.C. 112, second paragraph.

A copy of the rejection presented in the final office action is provided in Appendix A.

(10) Response to Argument

On page 7 of the brief, appellant argues that the cited Byrne and McLauchlin do not disclose the limitations of independent claims 1 and 11. Specifically, appellant argues that the combination of references does not teach "automatically using CCR data as part of the sub-order processing and payment." As a result, appellant argues, there is no motivation to modify Byrne to arrive at the claimed invention and the is no reasonable expectation of success when combining Byrne and McLauchlin. However, "automatic" usage of CCR data is not claimed, and therefore **appellant's arguments are directed to limitations that are not claimed**, and as such, the arguments are not valid. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant further asserts on page 7 that McLauchlin teaches away from the claimed invention. However, appellant's assertion is that McLauchlin teaches away from the feature of automated processing of CCR data to order and pay vendors. Again, **appellant's arguments are directed to limitations that are not claimed.** Accordingly, the prior art cannot teach away from a feature that is not claimed in the instant invention. The examiner notes that the claims have been viewed in light of the specification and have been afforded their broadest reasonable meaning. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, McLauchlin teaches that the features in the disclosure can be used to aid procurement systems by integrating government systems into the public sector (at least column 1, lines 22-42). One of ordinary skill in the art would have been motivated to combine the features of McLauchlin with Byrne (a procurement system) to provide this aid. Further, the motivation to combine also provides evidence of a reasonable expectation of success when combining Byrne and McLauchlin. McLauchlin suggests the combination with a procurement system, which Byrne provides.

On pages 10-11 of the brief, appellant asserts that King does not show keeping a local copy of the CCR database in the system database. The examiner recognizes that King does not teach keeping a local copy of the specific CCR database. However, King does teach that it is known to keep a local copy of an external database in claim 13. Similarly, the examiner recognizes that King does not disclose importing the specific CCR database into a public and private storage. However, King teaches importing a database into both private and public storage in at least column 2, lines 56-64. These teachings combined with McLauchlin's teaching of utilizing the CCR database disclose the claimed invention of claims 3 and 4. Claim 5 is not allowable for the same reasons cited above for claim 1.

On page 11 of the brief, appellant asserts that: "Gieselmann's DUNS numbers do not correspond to the claimed CCR as the CCR contains information not available in DUNS and thus the combination is inappropriate." The fact that Gieselmann's DUNS numbers do not correspond to the claimed CCR is irrelevant. Gieselmann's DUNS numbers correspond to the claimed DUNS numbers, which are validated in claim 7. Thus, the feature of validating DUNS numbers in Gieselmann discloses the DUNS number validation claimed.

On page 12 of the brief, appellant asserts that claims 9 and 19 are allowable for the same reasons that appellant has asserted that claims 1 and 11 are allowable. Accordingly, the reasoning above for claims 1 and 11 applies to claims 9 and 19.

On page 13 of the brief, appellant asserts that the combination used to reject claims 10 and 20 is arrived at through the use of impermissible hindsight and that there is no reasonable expectation of success in combining the references. However, appellant has offered no specific reasons to support these assertions. Accordingly, the examiner directs appellant to the final Office Action (attached as Appendix A) for the cited motivation to combine the references used to reject claims 10 and 20.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
Michael A. Misiaszek

Conferees:

Vincent Millin
Appeals Conference Specialist
Tech Center 3600

NAEEM HAQ
PRIMARY EXAMINER

Naeem Haq
Primary Examiner
Art Unit 3625

Acting SPE

APPENDIX A

The following grounds of rejections are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne (US 20050060235 A2) in view of McLauchlin (US 6754672 B1).

Byrnes discloses a system and method to support an electronic market place comprising:

- a communication network to communicate purchase requests (at least paragraph [0040])
- one or more buyers coupled to the network to issue a purchase order specifying items from two or more suppliers (at least Abstract)
- a server coupled to the network to receive the purchase order, the server generating sub-orders from the purchase order and sending the sub-orders to the two or more suppliers for fulfillment (at least paragraphs [0027] and [0036]: Hub or central server which handles sending of sub orders to merchants)
- receiving an acceptance from the vendor (at least paragraph [0052]: vendor acknowledges order and ships product)

Byrne does not disclose:

- accessing data from a Central Contract Registry (CCR) Database to retrieve vendor payment data
- paying the vendor using the CCR database

McLauchlin teaches that it is known to include accessing the Central Control Registry Database to retrieve vendor data (at least column 1, lines 43-64: agent uses CCR to retrieve vendor data) and paying the vendor using the data (at least column 1, lines 43-64: agent finalizes order) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with the accessing of the CCR Database to retrieve vendor payment data and paying a vendor using that data, as taught by McLauchlin, since such a modification would have provided a way to integrate government systems to the into the public sector to aid procurement systems (at least column 1, lines 22-42 of McLauchlin).

Claims 3-5 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin as applied to claims 2 and 12 above, and further in view of King, Jr. et al. (US 5319542, herein referred to as King).

Regarding Claims 3,13

The combination of Byrne and McLauchlin discloses the claimed invention except for:

- keeping a local copy of the CCR database in a system database

King teaches that it is known to include keeping a local copy of an external database (at least claim 13: catalog database is downloaded by customer) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with the keeping of a local copy of an external database, as taught by King, since such a modification would have provided a reduction of customer maintenance of their private data (at least column 2, lines 1-10 of King).

Regarding Claims 4,14

The combination of Byrne and McLauchlin discloses the claimed invention except for:

- importing the CCR data into a public data storage and a private data storage.

King teaches that it is known to include importing a database into a public data storage and a private data storage (at least column 2, lines 56-64: transmit catalog database to public and private catalog database) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with the importing of a database into a public data storage and a private data storage, as taught by King, since such a modification would have provided a reduction of customer maintenance of their private data (at least column 2, lines 1-10 of King).

Regarding Claims 5,15

The combination of Byrne and McLauchlin discloses the claimed invention except for:

- transferring data over a secure protocol

King teaches that it is known to include transferring data over a secure protocol (at least column 5, lines 10-13: system only allows authorized users to download data) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with transferring data over a secure protocol, as taught by King, since such a modification would have provided a reduction of customer maintenance of their private data (at least column 2, lines 1-10 of King).

Claims 6-8 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin as applied to claims 2 and 12 above, and further in view of Gieselmann et al. (US 20040117263 A1, herein referred to as Gieselmann).

Regarding Claims 6, 16

The combination of Byrne and McLauchlin discloses the claimed invention except for:

- using the CCR data to Register Vendors, Search and Select Vendors for solicitation of services and/or delivery of supplies; View Vendor Profile; or Electronic Transfer Funds or outstanding account payable

Gieselmann teaches that it is known to include using CCR data to register vendors (at least paragraph [0054]: companies registered using DUNS number) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with the using CCR data to register vendors, as taught by Gieselmann, since such a modification would have provided registration that does not require dedicated in-house computer resources (at least paragraph [0014] of Gieselmann).

Regarding Claims 7, 17

The combination of Byrne and McLauchlin discloses the claimed invention except for:

- validating the vendor's DUNS/CAGE data and Point of Contact data

Gieselmann teaches that it is known to include validating DUNS/CAGE data (at least paragraph [0054]: companies registered using DUNS number) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with the validating DUNS/CAGE data, as taught by Gieselmann, since such a modification would have provided registration that does not require dedicated in-house computer resources (at least paragraph [0014] of Gieselmann).

Regarding Claims 8, 18

The combination of Byrne and McLauchlin discloses:

- displaying Business Name; DUNS and CAGE Code; Socio Economic Factors; Business Type; Geographic Location; or NAICS/SIC Code (at least paragraph [0005]: class and geographic area are published to buyers)

Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin and Gieselmann as applied to claims 6 and 16 above, and further in view of Goodman et al. (US 20030088475 A1, herein referred to as Goodman).

The combination of Byrne, McLauchlin and Gieselmann discloses the claimed invention except for:

- receiving as a search parameter one or more of the following: Business Name; DUNS and CAGE Code; Socio Economic Factors; Business Type; Geographic Location; and NAICS/SIC Code

Goodman teaches that it is known to search for vendors based on vendor name and address (at least paragraph [0061]) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with the searching for vendors based on name and address, as taught by Goodman, since such a modification would have provided a convenient way to find a vendor (at least paragraph [0011] of Goodman).

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of McLauchlin and Gieselmann as applied to claims 6 and 16 above, and further in view of King and Muscavage, III et al. (US 20030126036 A1, herein referred to as Muscavage).

The combination of Byrne, McLauchlin and Gieselmann discloses the claimed invention except for:

- retrieving CCR public data and private data
- determining the vendor's business name and mailing address from the public data
- determining the vendor's electronic fund transfer (EFT) information from the private data
- using the EFT information to pay the vendor

King teaches that it is known to include retrieveing public and private data (at least column 2, lines 56-64: public and private catalog databases browsed by customer) and determine the vendor's business name and mailing address (at least column 4, lines 47-68: suppliers makes name and address available in database) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with retrieving public and private data and determining of vendor name and address, as taught by King, since such a modification would have

provided a reduction of customer maintenance of their private data (at least column 2, lines 1-10 of King).

Muscavage teaches that it is known to include determining the vendor's electronic fund transfer information (at least paragraph [0033]: automated clearinghouse uses EFT data to transfer funds from buyer to seller) and use this data to pay the vendor (at least paragraph [0033]: automated clearinghouse uses EFT data to transfer funds from buyer to seller) in a similar environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system and method to support an electronic marketplace, as taught by Byrne, with the determining vendor's EFT information and paying the vendor using this information, as taught by Muscavage, since such a modification would have provided a secure way to transfer funds in e-commerce (at least paragraphs [0003] and [0004] of Muscavage).